

## **REMARKS**

### **I. Introduction**

Claims 1 to 9, 11 to 16, 19 to 21, and 37 to 51 are currently pending. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 3 and 40 to 44 Under 35 U.S.C. § 102(e)**

Claims 1 to 3 and 40 to 44 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,547,721 ("Higuma"). It is respectfully submitted that Higuma does not anticipate the present claims as amended herein for at least the following reasons.

Claims 1 and 40 both recite a flexible shaft comprising "a moisture sensor disposed within a coupling connected to an end of the outer sheath configured to communicate sensor data corresponding to the presence of moisture within the outer sheath." Higuma describes an autoclavable endoscope with all susceptible parts of the endoscope, such as the observing means, illuminating means, and switch unit being sealed in an airtight or watertight manner. Although the Office Action states that Higuma describes a moisture absorptive member 158 *within the armor tube 35*, Higuma actually discloses the absorptive member 158 as being located within the switch 13, as shown in Fig. 22. It is clearly improper for the switch 13, which is clearly shown as being on the outside of the operation unit 3 and not on, near, or within the flexible tube 10, as shown in Fig. 1, to be considered as being "within the outer sheath". Furthermore, amended claims 1 and 40 recite the moisture sensor is disposed within a coupling, and no such coupling is described in Higuma. Furthermore, the moisture absorptive member 158 of Higuma is intended to absorb the steam to prevent deterioration of electronic parts. The moisture sensor as set forth in the present claims is configured to sense the presence of moisture and communicate this information to the user. The member 158 can only "display" the presence of moisture -- if at all -- when the device is disassembled after the use of the device, not during the use of the device in its intended fashion. The contention that "a[s] Higuma et al. disclose that moisture absorptive member may be removed . . . it follows that its appearance would communicate the presence of moisture (indicating the need for removal and replacement)" is not agreed with.

There is absolutely no disclosure, or suggestions, whatsoever by Higuma that the appearance of absorptive member communicates the presence of moisture. Rather, Higuma merely states that “[i]f the moisture absorptive member can be replaced with a new one, it would be more advantageous.” Col. 26, lines 4 to 6. Nothing in the foregoing statement constitutes a disclosure, or even a suggestion, that moisture absorptive member changes its appearance or otherwise in any manner communicates the presence of moisture. Thus, the contentions included in the Office Action are apparently based on nothing more than pure speculation or conjecture, which cannot support an anticipation rejection.

For at least these reasons, it is respectfully submitted that Higuma does not anticipate amended claim 1 or claim 40.

As for claims 2 and 3, which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that Higuma does not anticipate dependent claims 2 and 3 for at least the same reasons more fully set forth above in support of the patentability of claim 1.

As for claims 41 to 44, which depend from claim 40 and therefore include all of the features of claim 40, it is respectfully submitted that Higuma does not anticipate dependent claims 41 to 44 for at least the same reasons more fully set forth above in support of the patentability of claim 40.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 7 to 9, 11 to 16, 19, 48, and 49 Under 35 U.S.C. § 103(a)**

Claims 7 to 9, 11 to 16, 19, 48 and 49 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Higuma and U.S. Patent No. 6,071,233 (“Ishikawa”). As discussed above, Higuma does not disclose, or even suggest, all of the features included in claims 1 and 40. Claim 11 also recites a flexible shaft comprising “a moisture sensor disposed within a coupling connected to an end of the outer sheath configured to communicate sensor data corresponding to the presence of moisture.” As further set forth above, Higuma does not disclose, or even suggest, a moisture sensor disposed within a coupling configured to communicate sensor data corresponding to the presence of moisture. Ishikawa fails to cure this deficiency. Ishikawa fails to disclose, or even suggest, any moisture sensor. As such, it is respectfully submitted that the combination of Higuma and

Ishikawa does not render unpatentable claim 11, or any claim that depends from claim 1, 11, or 40.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**IV. Rejection of Claims 1, 2, 7 to 9, 11, 12, 14 to 16, 19, 37, 40 to 43 and 48 to 51 Under 35 U.S.C. § 103(a)**

Claims 1, 2, 7 to 9, 11, 12, 14 to 16, 19, 37 and 40 to 43 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,576,167 ("Noiles") and U.S. Patent No. 5,402,769 ("Tsuji"). Noiles describes a disposable stapling apparatus having a flexible sheath (60). As the Office Action concedes, Noiles does not disclose or even suggest a moisture sensor. The Office Action attempts to use Tsuji to cure this deficiency. However, Noiles and Tsuji, alone or in combination, still do not disclose all the limitations of independent claims 1, 11 and 40.

Tsuji describes an endoscope that includes a humidity sensor (22) for detecting water leakage in the tip section (15) of the endoscope. The humidity sensor (22) is located just outside the leakproof member 21, which houses the solid-state imaging device (17), as shown in Fig. 1 (col. 4, lines 21 to 69). Thus, the sensor of Tsuji is intended to notify the user of a leak before the imaging device is damaged (col. 2, lines 49 to 52). The sensor hereof is configured to notify the user after moisture has penetrated into the outer sheath, so the user can remedy the leak before corrosion of the drive shafts, electronic, or electric components occurs. Furthermore, the sensor 22 of Tsuji is not located "within the coupling" as recited in independent amended claims 1, 11, 37, and 40, as Tsuji does not disclose any such coupling.

Furthermore, there is no suggestion or motivation to combine Noiles with Tsuji. The Office Action states the motivation is to enhance the reusability of the device of Noiles by enabling sterilization, however this teaches away from Noiles. One of the stated objectives of Noiles is to "provide economically disposable surgical staplers" (col. 2, lines 25 to 26). A combination is not proper if the proposed modification renders the reference unsatisfactory for its intended purpose or changes the principle of operation of a reference (M.P.E.P. § 2143.01), and it is improper to combine references where the references teach away from their combination. Therefore, there is no suggestion or motivation to make a modification to Noiles that

would make the device reusable and more costly. For at least these reasons, it is respectfully requested that this rejection be withdrawn.

As for claims 2 and 7 to 9, which ultimately depend from claim 1 and therefore include all of the features of claim 1, it is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable these dependant claims for at least the same reasons more fully set forth above in support of the patentability of claim 1.

As for claims 12, 14 to 16 and 19, which ultimately depend from claim 11 and therefore include all of the features of claim 11, it is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable these dependant claims for at least the same reasons more fully set forth above in support of the patentability of claim 11.

As for claims 42 and 43, which ultimately depend from claim 40 and therefore include all of the features of claim 40, it is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable these dependant claims for at least the same reasons more fully set forth above in support of the patentability of claim 40.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 38 and 39 Under 35 U.S.C. § 103(a)**

Claims 38 and 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over Noiles. As described above, and conceded by the Office action (Paragraph 10b), Noiles does not disclose or even suggest a moisture sensor. Since amended claim 38 includes a moisture sensor, it is respectfully requested that this rejection be withdrawn.

**VI. Rejection of Claims 3, 13 and 44 Under 35 U.S.C. § 103(a)**

Claims 3, 13 and 44 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Noiles, Tsuji and U.S. Patent No. 6,099,464 ("Shimizu"). As further set forth above, Noiles and Tsuji, alone or together, do not disclose all of the features of independent claims 1, 11 and 40. Shimizu fails to cure this deficiency as Shimizu fails to disclose, or even suggest, any moisture sensor. As such, it is respectfully submitted that the combination of Noiles, Tsuji and Shimizu

does not render unpatentable claims 3, 13, and 44 depending from claims 1, 11 and 40, respectively.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

**VII. Rejection of Claims 4 to 6, 20, 21 and 45 to 57 Under 35 U.S.C. § 103(a)**

Claims 4 to 6, 20, 21 and 45 to 57 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Noiles, Tsuji and U.S. Patent No. 4,654,701 ("Yabe"). It is noted that there are no claims 52 to 57 in the present application. It appears that claims 45 to 47, rather than claims 45 to 57, were intended to be rejection. Clarification is nevertheless requested. As further set forth above, Noiles and Tsuji, alone or together, do not disclose all of the features of independent claims 1, 11 and 40. Yabe fails to cure this deficiency as Yabe fails to disclose, or even suggest, any moisture sensor. As such, it is respectfully submitted that the combination of Noiles, Tsuji and Yabe does not render unpatentable dependent claims 4 to 6, 20, 21 and 45 to 47.

In view of the foregoing withdrawal of this rejection is respectfully requested.

**VIII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

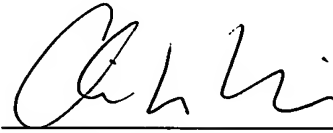
Any fees for extension(s) of time or additional fees required in connection with the filing of this response, are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to

credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,

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